

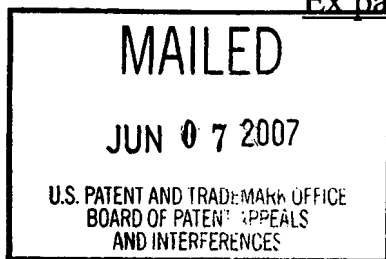
UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JON A. WOLFF and VLADIMIR G. BUDKER



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Application No. 09/707,000

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was returned to the Board of Patent Appeals and Interferences (BPAI) on January 29, 2007 following a prior return mailed on June 19, 2006. The prior return was returned for submission of a new appeal brief that fully complies with the new rules under 37 CFR 41.37(c)(1)(v). The new appeal brief is defective for the following reasons:

I. The Summary of claimed subject matter in the brief is not fully compliant.

37 CFR § 1.37(c)(1)(v) states in part:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated . . .

. . .

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in **each of the independent claims** involved in the appeal, which shall refer to the specification by page and line number and to the drawings, if any by reference characters. (Emphasis added)

Appellants “V. SUMMARY OF THE CLAIMED SUBJECT MATTER” in Appellant’s amended brief filed June 29, 2006 is a general description of the subject matter involved in the claims on appeal but does not **specifically** map the subject matter of **each** of the **independent claims** (1 and 39) to its location in the specification as outlined above.

When the Office holds the brief to be defective solely due to appellant’s failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office’s requirement will result in dismissal of the appeal. See MPEP § 1215.04 and §711.02(b).

II. Additionally, the prior return ordered the examiner to properly consider the declaration filed by appellants on June 16, 2004. We find no response from the examiner in regards to this order.

The examiner is directed to The Manual Of Patent Examining Procedure (MPEP) 8th Ed., Rev. 2, May 2004, (in effect at the time of the filing of the declaration) which reads in part:

**716 Affidavits or Declarations Traversing Rejections, 37 CFR 1.132**

*37 CFR 1.132 Affidavits or declarations traversing rejections or objections.*

When any claim of an application or a patent under reexamination is rejected or objected to, any evidence submitted to traverse the rejection or objection on a basis not otherwise provided for must be by way of an oath or declaration under this section.

It is the responsibility of the primary examiner to personally review and decide whether affidavits or declarations submitted under 37 CFR 1.132 for the purpose of traversing grounds of rejection are responsive to the rejection and present sufficient facts to overcome the rejection.

Consideration of the declaration is required.

Accordingly, it is ORDERED that the application is returned to the Examiner to:

- 1) hold the Appeal Brief filed on June 29, 2006, defective;
- 2) notify appellants to file a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v);
- 3) consider the paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v);

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- 4) for proper consideration of the declaration filed June 16, 2004;
- 5) to make of record to the file, and notify appellants of the determination of such consideration, and
- 6) for such further action as may be appropriate

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By: *Patrick J. Nolan*  
Patrick J. Nolan  
Deputy Chief Appeals Administrator  
(571) 272-9797

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cc: MIRUS CORPORATION  
505 SOUTH ROSA RD  
MADISON WI 53719